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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,219	09/14/2006	Werner Brandstatter	335.0112	3718
76444	7590	11/10/2010		
Setter Roche LLP P.O. Box 780 Erie, CO 80516			EXAMINER NGUYEN, DONGHAI D	
			ART UNIT 3729	PAPER NUMBER
			NOTIFICATION DATE 11/10/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jamie@setterroche.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/566,219	<b>Applicant(s)</b> BRANDSTATTER ET AL.	
	<b>Examiner</b> DONGHAI D. NGUYEN	<b>Art Unit</b> 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 21-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☒ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/12/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I (Claims 1-20) in the reply filed on August 23, 2010 is acknowledged. Thus claims 21-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention, there being no allowable generic or linking claim.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Austria on 07/29/2003. It is noted, however, that applicant has not filed a certified copy of the A 1202/2003 and A 1203/2003 application as required by 35 U.S.C. 119(b).

### ***Drawings***

3. The drawings are objected to because lines and letter are not well defined, uniformly thick and none-English alphabet. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be

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necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The disclosure is objected to because of the following informalities: “504” (page 5, line 6) should be: --604--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“performing any required final trim of the shaped part and possibly any required punching, or the creation of a perforation pattern, prior to, during or after shaping of the shaped part” (claim 1, lines 5-7); “at most” and “at least” (claim 8, lines 2-3); “up to” (claim 16, line 2) are vague and indefinite since the resulting claim does not set forth the metes and bounds of the claimed invention because it's uncertain as to whether the step of final trimming or punching

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being performed or not and what is the range of ratio of Zinc and the range of time above the austenizing temperature applicants referred to.

“the heat expansion” (claim 18, line 2); “the time” (claim 16, line 2); “the holding temperature” (claim 17, line 2) lack antecedent basis.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-9, 14 and 20, as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 6,566,604 to Kefferstein et al.

Regarding claim 1, Kefferstein et al disclose a method for producing hardened structural parts from sheet steel, comprising: shaping at least one shaped part made of sheet steel (see Col. 1, lines 56-57) provided with a cathodic corrosion protection coating (see Col. 1, lines 59-64); performing any required final trim of the shaped part and possibly any required punching, or the creation of a perforation pattern, prior to, during or after shaping of the shaped part (optional); subsequently heating the shaped part, at least over partial areas, under the admission of atmospheric oxygen to a temperature which permits austenizing of the steel material (see Col. 2, lines 20-22); and thereafter transferring the structural part to a mold-hardening tool and performing mold-hardening in the mold-hardening tool, wherein the structural part is cooled by

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the contact with and pressing by the mold-hardening tool and is hardened thereby (see Fig. 2 see Col. 2, lines 63-65).

Regarding claims 2-9, Kefferstein et al disclose the coating is a mixture comprising zinc, and the mixture contains at least one element of magnesium and/or silicon and/or titanium and/or calcium and/or aluminum with affinity to oxygen in a total amount of 0.1- 15% wt in relation to the entire coating (see Col. 3, lines 54-65), and wherein in the course of heating the sheet steel to the temperature required for hardening, a skin of an oxide of the element(s) with affinity to oxygen is formed a coating having at least two phases of a zinc-rich and an iron-rich phase, wherein the iron-rich phase is formed at a ratio of zinc to iron of at most 0.95 (Zn/Fe 0.95), and the zinc-rich phase at a ratio of zinc to iron of at least 2.0 (Zn/Fe > 2.0) and , wherein the iron-rich phase has a ratio of zinc to iron of approximately 30:70, and the zinc-rich phase has a ratio of zinc to iron of approximately 80:20 (inherent, Kefferstein et al disclose the same materials and process as claimed therefore the same results are expected).

Regarding claim 14, Kefferstein et al disclose the cathodic corrosion-protection coating having a constant thickness over the structural part as (see Figs. 1-2).

Regarding claim 20, Kefferstein et al disclose pressing and hardening the shaped part with the molding tool halves substantially simultaneously over the full surface and with the same force (see Figs. 1-2).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 10-14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kefferstein et al in view EP 1,439,240 to Imai et al.

Kefferstein et al do not disclose the coating contains individual areas with zinc proportions > 90% zinc and at an initial thickness of 15  $\mu\text{m}$ , the coating has a cathodic protection effect of at least 4 J/cm<sup>2</sup> after the hardening process and a liquid metal bath at a temperature of 425°C to 690°C or 440°C to 495°C with subsequent cooling of the coated sheet, wherein the time above the austenizing temperature at 780 to 950°C is up to 10 minutes. Imai et al teach the above limitations (see paragraphs 76 and Table 15 of Imai) for forming a steel material having high tensile corrosion resistance. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Kefferstein et al by utilizing the process of coating the steel as taught by Imai et al for forming a steel material having high tensile corrosion resistance (see Abstract).

11. Claims 15, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kefferstein et al.

It would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to choose any size for the shaped part such that the final shaped part having a desired shape, since it has been held that where the general conditions of a claim are disclosed (i.e. shaping, trimming and heat treatment the steel sheet) in the prior art,

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discovering the optimum or workable ranges (i.e., size of shaped part) involves only routine skill in the art.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art references cited for their teachings of producing hardened structure parts from sheet steel.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DONGHAI D. NGUYEN whose telephone number is (571)272-4566. The examiner can normally be reached on Monday-Friday (9:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on (571)-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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October 1, 2010

/Donghai D. Nguyen/

Primary Examiner, Art Unit 3729